



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,040	11/13/2001	Craig Priest	13808	6305

293 7590 07/13/2006

Ralph A. Dowell of DOWELL & DOWELL P.C.
2111 Eisenhower Ave
Suite 406
Alexandria, VA 22314

EXAMINER

BLAIR, DOUGLAS B

ART UNIT	PAPER NUMBER
----------	--------------

2142

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,040

Applicant(s)

PRIEST ET AL.

Examiner

Douglas B. Blair

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-21, 23-25 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-21, 23-25 and 27-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/13/01

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claim 19 is withdrawn in view of the newly discovered reference(s) to U.S. Patent Number 6,052,122 to Sutcliffe et al. in view of U.S. Patent Number 6,865,161 to Sponaugle et al.. Rejections based on the newly cited reference(s) follow.
2. To overcome the newly discovered references it is suggested that the applicant should more specifically define the step of calculating costs of service in the claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 17, 23-24, and 27-34 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by U.S. Patent Number 6,052,122 to Sutcliffe et al..
5. Sutcliffe teaches a method of operating a message exchange device (as in exemplary claim 23) comprising: storing greetings originating with each of a plurality of users using said message exchange device (col. 9, lines 25-48); obtaining from each of said plurality of users an indicator of whether that user wishes to pay to use said message exchange device, thereby classifying each of said plurality of users as a paying or non-paying user (col. 4, lines 9-10 and

Art Unit: 2142

col. 6, lines 34-67, the “stamps” indicate whether or not a user has paid for service.); allowing paying users access to all of said stored greetings (col. 4, lines 9-10 and col. 6, lines 34-67); allowing non-paying users access to only those greetings originating with paying users (col. 4, lines 9-10 and col. 6, lines 34-67, user’s can only contact other users by using their “stamps”); calculating costs of using said message exchange device for each of said paying users based on time each of said paying users uses said message exchange device (col. 4, lines 9-10 and col. 6, lines 34-67, the stamps provide a measure of time in that a user that uses more stamps uses more time.).

6. The rest of the independent claims are also taught by Sutcliffe. Claim 17 features a broader method than claim 23 and is thus rejected for the same reasons as claim 23. Claim 27 features a message exchange server that performs the method of claim 17 and Sutcliffe teaches a message exchange server (Server 18 in Figure 1). Claim 30 features instructions for causing a message exchange server to perform the method of claim 23. Claim 31 features the same method as in claim 17. Claims 32 and 33 feature the same method as in claim 23.

7. As to claims 24 and 28, Sutcliffe teaches a method wherein greetings comprise voice messages and allowing paying users comprises allowing paying users to listen to all of the stored greetings (col. 9, lines 25-48).

8. As to claim 29, Sutcliffe teaches a server with memory that stores an amount representative of prepayment of users paying to use said server (col. 4, lines 9-10 and col. 6, lines 34-67).

9. As to claim 34, Sutcliffe teaches a method wherein measuring use of a device comprises measuring the number of greeting each paying user has accessed (col. 9, lines 24-48).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 18-20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,052,122 to Sutcliffe et al. in view of U.S. Patent Number 6,865,161 to Sponaugle et al..

12. As to claim 18, Sutcliffe teaches the method of claim 17, however Sutcliffe does not teach bridging a call between a plurality of users.

Sponaugle teaches a method of bridging a call between a plurality of users of message exchange device (col. 5, lines 8-44) in the context of a dating service (col. 8, lines 25-42).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the applicant's invention to combine the teachings of Sutcliffe regarding the management of a message exchange system with the teachings of Sponaugle regarding the bridging of a telephone call because voice communication enhances a users ability to communicate.

13. As to claims 19 and 25, a telephone call is considered "near real time" so therefore claim 19 is rejected for the same reasoning as claim 18.

14. As to claim 20, both the cited portions of the Sutcliffe and Sponaugle references discuss collecting fees before providing services.

Art Unit: 2142

15. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,052,122 to Sutcliffe et al. in view of U.S. Patent Number 5,963,951 to Collins.

16. As to claim 21, Sutcliffe teaches the method of claim 17 including the storage of voice greetings however Sutcliffe does not explicitly teach the use of a telephone to retrieve such greetings.

Collins teaches the retrieval of voice greetings via a telephone interface in the context of an online dating service (col. 6, lines 47-64).

It would have been obvious to one of ordinary skill in the Computer Networking art to combine the teachings of Sutcliffe regarding the management of a message exchange system with the teachings of Collins regarding the use of a telephone to access voice greetings because Sutcliffe never mentions any specific way to access voice greetings and telephones were prevalent at the time of the applicant's invention and therefore a logical choice for accessing stored audio.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B. Blair whose telephone number is 571-272-3893. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2142

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Douglas Blair

DBB



BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER